

No. 18,774

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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PAUL SACHS ORIGINALS Co.,

*Appellant,*

*vs.*

JOHN SACHS and LEO HIRSCH, Doing Business as  
SACHS OF CALIFORNIA, a Partnership,

*Appellees.*

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## BRIEF FOR APPELLEES.

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## BRIEF FOR APPELLEES.

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### Restatement of the Case.

Plaintiff has extracted isolated portions of the evidence and findings of the trial court which plaintiff considers favorable to its case; plaintiff has completely ignored almost every unfavorable fact in the record and finding in the Memorandum Decision so carefully prepared by Judge Albert Lee Stephens, Jr. [R. 30-51; 217 F. S. 407-417].

In order to gain a complete understanding of all the facts in issue, as well as the actual decision made by the trial court, it is, of course, essential to read that entire decision [R. 30-51]. At this time we submit the following facts are *substantially uncontradicted* although not accurately reflected in appellant's "Statement of the Case" or anywhere else in appellant's opening brief:

1. The actual trade-marks used by plaintiff consist of two separate three-word combinations, "Paul Sachs Original" and "Don Sachs Original", in which the first two words in each trade-mark, *i.e.*, "Paul Sachs" and "Don Sachs" are *invariably* printed in the same size, color, and type. In recent advertising by plaintiff, the term "Paul Sachs" frequently appears in *block letters* with the word "Original" in *script*; "Don Sachs" frequently appears in *script* with the word "Original" in *block letters* [See Pltf. Exs. 26, 27, 28, 29, 30, 32, 33, 72]. Earlier advertising had all three words "Paul Sachs Originals" in capital block letters [Pltf. Exs. 8, 9, 18, 19, 20, 21, 22, 23, 36, 38, 49].

a. Where the word "Original" is written in script with "Paul Sachs" in capital block letters, or where "Original" appears in block letters with "Don Sachs" in script, it might well be argued this gives the word "Original" greater emphasis.

b. Plaintiff has *never* utilized any advertising or label in which the single word "Sachs" has been used or emphasized as the major or dominant word in the trade-mark, label or advertisement.

c. Although plaintiff was required to disclaim exclusivity in the word "Original" when it registered the trade-mark "Paul Sachs Original" "*apart from the mark as shown and described*" [R. 37], and plaintiff did not attempt to register the word "Original" as part of its trade-mark "Don Sachs", nevertheless, *every label and hang-tag and virtually every advertisement uses the three-word combinations "Paul Sachs Original" and "Don Sachs Original"* [See Pltf. Exs. 3-23 incl., 25-30 incl., 32-34 incl., 72-75B incl].

2. Defendants' trade-name also consists of a three-word combination, "Sachs of California", which is the firm name of the business owned and operated by John Sachs in Los Angeles, California. This business name appears in full on every label, hang-tag, mailing piece, and all advertisements prepared by defendants. [See Deft. Exs. A, B, C, D, E, F, G, H, I, J, K, R, S, T.]

3. *There is no substantial similarity or identity in appearance, size, color, type, or printing between the labels, hang-tags, advertising, or mailing pieces of plaintiff and defendant; nor is there any identity or similarity of sound when the two names are taken in their entirety, i.e., "Paul Sachs Original" does not sound like "Sachs of California" [See Findings of Trial Court, R. 50].*

4. Plaintiff does not contend defendants acted in bad faith or with any intention of deceiving or "palm-ing off" their goods. Plaintiff's contention is that defendants acted with "constructive notice" of the registered trade-mark "Paul Sachs Original" and of the application for registration of "Don Sachs" filed ten days before defendants commenced doing business. Notwithstanding twenty months of alleged competitive use in the same territory, plaintiff produced no evidence whatever of actual confusion, damage or injury.

5. Plaintiff conceded in the trial court that retail buyers for stores "are buying the merchandise entirely without respect to trade-mark and thus would purchase the merchandise from the individual regardless of what mark he may use" (Plaintiff's Trial Brief, p. 3). Since all store buyers are experienced in the field of purchasing women's dresses from manufacturers, they

are, thus, *conceded* by plaintiff to be acquainted with the identity of each of the parties with whom they are dealing, *i.e.*, “Paul Sachs Originals Co.” (of Missouri) or “Sachs of California”. Plaintiff does not suggest how or in what manner there is the slightest “reasonable likelihood of confusion” in connection with the sale of its products to the retail trade.

6. With respect to the women customers who eventually purchase dresses in the various retail stores, plaintiff chooses to *ignore* the sophisticated personal taste involved in the selection of women’s dresses by individual customers. *Uncontradicted evidence* on this point was summarized in the decision of the trial court as follows:

“As can readily be proved from what has already been said, women who purchase ready-to-wear garments possess a certain sophistication concerning the language of the marketplace and they are discerning and discriminating. The number and variety of trade-marks used by manufacturers are legion and the distinctions are subtle and yet they are understood and appreciated by wholesale and retail customers.” [R. 49].

Both wholesale and retail women customers have distinguished for many years between dress manufacturing firms whose names are substantially similar [See Exs. P and Q]. Compare for example:  
Alexander’s of California—Jeannette Alexander  
Bette of California—Betty Lou of California  
California Colormates—California Playmates  
Debby of California—Debbie Reynolds Originals  
Ellson of California—Elon of California  
Gallant of California—Gallina of California  
Junior Miss of Calif.—Junior Petites of California



Loubella Originals—Lou-Ette Originals  
Jerry Miller of Calif.—Julie Miller of Calif.  
Saba of California—Sa'Bett of Calif.

We are not here dealing with two low-priced mass-produced articles which are substantially identical in form and content, distinguishable only by name or trademark (*e.g.*, soap products), nor are we dealing with a copy or imitation of a Dior or Balenciaga "original" dress, bearing a fraudulent label designed to mislead the public. We are here involved with the personal taste of sophisticated buyers who will only purchase if satisfied with the style, quality, fabric and price of the particular dress, and if it "fits" and is "becoming" to the individual purchaser. The *uncontradicted evidence* on this point is summarized in Point I, *post*.

### Primary Issues.

The primary factual issues in the case, upon which appellants have presented a distorted picture of the evidence, are as follows:

1. Are the trade-marks of the parties readily distinguishable by the ultimate retail purchasers exercising reasonable discrimination?
2. Is there any genuine likelihood of confusion by trade customers or ultimate purchasers from retail stores?

The primary legal issue in the case is whether or not appellants can maintain a monopoly in the use of the surname Sachs although neither their trade-marks, labels or advertising at any time since the inception of their business have featured the name Sachs as distinguished from the remainder of their trade-mark "Paul Sachs Original" and their recently adopted "Don Sachs Original".

## Summary of Argument.

### I.

No actual competition between parties in merchandise or customers.

### II.

The surname "Sachs" is not the "dominant" part of plaintiff's trade-marks.

### III.

Plaintiff's substantive rights are not enlarged by the "incontestability clause" of the Trade-mark Act of 1946.

### IV.

Defendant's right to use his own surname in his own business cannot be defeated by plaintiff's registration of two different trade-marks which have not been, nor are they likely to be, confused with defendant's tradename.

### V.

The legal test of "likelihood of confusion" is *probability*, not *possibility*. Findings of fact by the trial court should be sustained even "where reasonable minds might differ".

### VI.

Trade-marks must be considered "as a whole" with due regard to:

- (1) Similarity in appearance, sound and context;
- (2) Degree of care likely to be exercised by purchasers; and
- (3) Whether there is colorable imitation, fraudulent advertising, or honesty and good faith exercised by defendant.

VII.

Plaintiff's cases involving deliberate misappropriation of a fanciful trade-mark are not in point.

VIII.

Defendant's tradename "Sachs of California" consists of a three-word combination which has acquired secondary meaning identifying defendants and their merchandise. There is no probability (likelihood) of confusion with plaintiff's trade-marks.

POINT I.

**Plaintiff Errs in Contending That the Merchandise Manufactured by the Parties, the Methods or Channels of Sale, and the Wholesale and Retail Customers Are the Same (App. Op. Br. pp. 11-28).**

In the trial court plaintiff makes a series of contentions completely disproved by the evidence, including without limitation:

(a) That the dresses made by the parties are "physically identical" (Plaintiff's District Court Brief, p. 18).

(b) That the parties "operated identically in selling their merchandise at the wholesale level" (*Idem.*, p. 19).

(c) That the parties "sell to the same stores" (*Idem.*, p. 19).

Because the trial court made adverse findings on these very issues of claimed identity *raised by the plaintiff*, criticism is now levelled against the District Court for "not applying the proper standard" (App. Op. Br. p. 12). Yet in almost the same breath, appellant maintains that "the goods of the parties are *for all practical purposes identical*" (App. Op. Br. p. 12). Even if the

goods were identical, plaintiff would be unable to sustain its claims of trade-mark infringement and unfair competition because there is no confusing similarity in the appearance of the marks of the respective parties [R. 50]. But the goods are *not* identical “for all practical purposes” or otherwise; the methods and channels of sale are different; and neither the retail stores nor the eventual women customers who buy the dresses are the same.

1. Plaintiff and Defendants Do Not Manufacture the Same Style or Type of Dress, But Each Designs Its Respective Line of Dresses for Women Customers With Different Shapes and Figures.

Plaintiff argues that both plaintiffs’ and defendant’s dresses are sold “to the same clientele”; and that since “a 30-year old woman and a 17-year old girl buy the same dresses” the evidence “proved that the dresses of the parties did not appeal to different segments of the market” (App. Op. Br. pp. 22-23). Here again appellant distorts the evidence which clearly shows that only women of certain physical measurements and proportions could or would purchase defendant’s merchandise; and that only women of different physical proportions, figure, and measurements could or would purchase plaintiffs’ merchandise.

Each manufacturer deliberately caters to a completely different segment of the market; any discerning woman shopper immediately knows and observes the difference because one manufacturer’s dress would fit her, and the other could not possibly do so. As found by the trial court:

“. . . each manufacturer strives to have a distinctive ‘line’ . . . To the extent that it is suc-

cessful, the sales in part reflect the effort and *the manufacturer stays with that category . . .* The line is designed to fit women whose figures meet a certain combination of measurements and whose tastes are satisfied by the line offered.” [R. 35].

Defendants manufacture only one category of female dress, which is technically known in the garment industry as a “young missy” dress [R. Tr. 382]. This does not mean the woman who wears the dress must be chronologically young, but she must have a “youthful figure” of *certain physical dimensions* in order to have the dress fit the woman and the woman fit the dress, to wit: (1) high bust, (2) narrow waist, and (3) trim hips: *e.g.*, in size 12 the “young missy” dress manufactured by defendants is cut as follows: bust 36, waist 26½, hip 37 [R. Tr. 413]. This “young missy” dress will fit only this so-called “youthful figure”, *i.e.*, in size 12 the bust measurement of the woman wearing the dress must be approximately 35, waist 25½, hip 36 [R. Tr. 412]. The “young missy” term does *not* refer to the age of the customer but to her figure:

“It doesn’t make any difference how old a woman is, if she would fit that size she would be a young missy customer” [R. Tr. 395].

The *true* fact is that the physical measurements of defendants “young missy” dresses are substantially different from plaintiff’s “misses” dresses, and nearly every witness testified to these physical differences. Morrell: The “misses” dresses must be worn by a “more mature woman”, “more conservative”, “fuller bustline”, “a little more in the hipline” [R. Tr. 268-

269]. Weishar: The “young missy” dress is “a younger dress” for a “younger figure”, “the styling is different”, “a different type of neckline”, “a higher bustline” [R. Tr. 457].

There is no evidence before the Court that the plaintiff has ever at any time manufactured a “young missy” dress or any dress which conforms to the physical measurements of the dress line manufactured by defendants and other “young missy” dress manufacturers. On the contrary the physical measurements for *all* “misses” garments sold and offered for sale in the stores by women apparel manufacturers are *one to two inches larger in each basic measurement; i.e.,* in size 12, the bust is 37, waist 27½, hipline “a good 39” [R. Tr. 431].

It is of utmost importance and significance that Mr. Abrams, plaintiff’s President, was present in Court during the entire trial and yet at no time attempted to contradict defendants’ evidence as to the physical measurements of “misses” dresses as distinguished from “young missy” dresses. The only inference which can be drawn from his failure to deny, contradict or explain defendants’ evidence is that the physical measurements of plaintiff’s dresses were *in fact* those described by defendants’ witnesses as applicable generally to all “plaintiff’s” dresses. If plaintiff had ever manufactured any dress which had the *physical measurements* of defendants’ “young missy” dresses, plaintiff’s President would certainly have so testified.

Reference made by plaintiff’s counsel (App. Op. Br. p. 20) to the “same coincidence of sizes” in both parties’ lines of dresses is misleading. Sizes 8 to 16 apply to every category in the dress field, whether it

be junior, junior petite, young missy, misses, women's or half sizes. However, the *physical measurements and "styling" of each category of dress in the same size are completely different and are made to fit a different size, shape and figure of girl or woman* [Morrell, R. Tr. 263; Hope Sachs, R. Tr. 394].

As testified by Mr. Weishar, the "young missy dress is a completely different type of dress" than the corresponding size of *misses dress*", "it is *not* the size range; it is the styling that goes into the size that is the most important thing, to distinguish where it categorically fits" [R. Tr. 480].

Plaintiff thus ignores the most important single factor in the sale of both plaintiff's and defendants' dresses, to wit, they must "*fit*" the customer. These dresses are in the so-called "ready-to-wear" field in which specialty dress shops "don't alter" [R. Tr. 297]; department stores "charge for alterations" [R. Tr. 463]. A dress "must fit as is, or no sale" [R. Tr. 297]; "if it doesn't fit the customer she doesn't buy it" [R. Tr. 473].

**2. Plaintiff's Counsel Is Completely in Error in Contending That the "Trade Recognizes No Distinction" Between the "Misses" Dresses Manufactured by Plaintiff and the "Young Missy" Dresses Made by Defendants.**

Plaintiff argues that the "trade recognizes no distinction" between the so-called "misses" dresses manufactured by appellant and the so-called "Young Missy" dresses manufactured by defendant (App. Op. Br. pp. 23-26).

The trial court made detailed findings upon the differences between the various types of lines manufac-

tured by plaintiff and defendants: “each manufacturer strives to have a distinctive ‘line’” [R. 46]. In answer to plaintiff’s contention that the trade does not recognize a distinction, the Court said:

“This conclusion is unwarranted” [R. 48].

The evidence clearly supported the finding made by the trial court. Mr. Weishar expressly testified to the names of four manufacturers on the East Coast (Joan Lee, Victoria, Candy Frocks and Normay), and four manufacturers on the West Coast (Sachs of California, Dresscapades, Lido Casuals and Jerry Miller), each of whom is “known in the trade and understood in the trade as a producer solely of young missy dresses” [R. Tr. 471, 472, 473, 488]. Significantly, Mr. Weishar was unable to name a single manufacturer producing *both* “misses” and “young missy” dresses [R. Tr. 479].

Herman Schechter, owner of California Buying Services Incorporated, buying for over one hundred stores throughout the United States, testified that he could “very easily” determine whether a particular dress was a “young missy” garment because “*there are certain manufacturers who make young missy*” and “*each particular manufacturer in our market more or less stands for some particular type of garment or item he makes*”; *some manufacturers only make “women’s sizes”; some make “young missy”; “usually a manufacturer who makes a category stays with it”* [R. Tr. 489, 493].

Even plaintiff’s witness, Edward Silk, upon cross-examination, testified to the existence of a separate category of dresses known as “young missy”;

“Q. . . . Is there such a characterization as a young missy dress? A. Yes. There is such a thing” [R. Tr. 157].



3. Plaintiff Errs in Contending That Plaintiff and Defendants “Operate Identically in Selling Their Merchandise on the Wholesale Level” (App. Op. Br. p. 21).

Plaintiff argues “there is no distinction in trade channels” through which the respective parties market their dresses, and that “the parties operate identically in selling their dresses on the wholesale level” (App. Op. Br. p. 21).

The uncontradicted evidence is that except for one salesman employed by defendants to canvas stores in California, the great bulk of defendants’ business is done through *channels not utilized by plaintiff*, to wit: (1) markets held by California Fashion Creators; (2) wholesale buying services having headquarters or offices in Los Angeles, who buy for hundreds of stores throughout the country; and (3) a Los Angeles showroom.

Mr. Sachs testified [R. Tr. 514] that 30% to 35% of the annual business of the defendants was generated by the two markets of California Fashion Creators held semi-annually in January and June of each year, which is “open only to manufacturers of California merchandise”; each Market Weeks lasts for a period of four days and approximately 30,000 invitations are sent to retail stores, specialty shops, and department stores throughout the United States to solicit attendance by buyers [R. Tr. 346]. It was stipulated during 1961 buyers attended from all 50 states of the United States and, in addition, buyers came from Australia, Belgium, Canada, Cuba, Guam, Mexico, and South Africa [R. Tr. 355]. “The primary purpose of the Market Week” is to solicit orders “from these buyers who attend from all over the United States and from other parts of the world” [R. Tr. p. 347].

Mr. Sachs also testified that “a high percentage” of the defendants’ annual business is generated by the “dozen or so” national wholesale buying services which have offices in Los Angeles and buy for hundreds of stores throughout the country [R. Tr. 514]. The trial court expressly found that “a large segment of the business done by defendant Sachs of California consists of sales made through those same buying services with which defendant John Sachs previously did business under the name of ‘Steffi of California’ ”; these buying services maintaining offices in the City of Los Angeles and arranging for purchase of dresses from clients “numbering for each buying service from fifty to three hundred stores located in various parts of the country” [R. 41]. Appellant did not contend that it ever transacted any business with any buying service, and, as found by the court, appellant was not privileged to exhibit its merchandise or sell the same at the semi-annual markets held by California Fashion Creators: the two major wholesale trade channels utilized by defendant.

It is, therefore, apparent from the *uncontradicted evidence* that plaintiff and defendants do *not* “operate identically” but that the largest volume of defendants’ business comes from sources not utilized by and not available to plaintiff, to wit, plaintiff is *ineligible* to show its merchandise at the markets held semi-annually by California Fashion Creators; plaintiff has produced *no evidence* of sales to or through national buying services which have headquarters or offices in Los Angeles; and, of course, plaintiff maintains *no* Los Angeles showroom—nor do defendants maintain showrooms in St. Louis, Missouri, or New York City.

4. Plaintiff Errs in Contending That Plaintiff and Defendants Both "Sell to the Same Stores".

Under the heading "To The Sam Stores", appellant argues that "both parties had sold their dresses to identical stores in California"; "sales to not just the same types of stores, but to the very same stores" (App. Op. Br. p. 21). The argument is grossly misleading.

The only evidence offered by plaintiff to sustain this contention is that in the year 1952 (eleven years ago), plaintiff sold a few hundred dollars in merchandise to certain May Co. stores [Pltf. Ex. 78]; also that between 1952 and 1956, plaintiff sold to the Style Shop in Salinas an average of \$110.00 per year, and in 1960 \$56.83 [Pltf. Ex. 78]. There is no *evidence* that plaintiff sold to any May Co. store since 1952. Defendants "once" sold dresses to The Style Shop [R. Tr. 545] and presently sell to the May Co.; but the May Co. buyer, Mr. Weishar, testified that he had never heard of plaintiff or its merchandise [R. Tr. 455]. Plaintiff's contention of "sales to the same stores" is, therefore, illusory and misleading. There is evidence of only *one overlapping sale to the same store*—upon a minimal order.

It is most significant to us that although plaintiff claims to have sold an estimated "three hundred California accounts" and to have "one hundred active accounts annually" in over 75 different cities in the State of California [R. Tr. 114, 115] and "defendants have sold their dresses to some one hundred seventy-five to two hundred accounts in California" [R. Tr. 540], and notwithstanding the fact that the parties were selling their merchandise to hundreds of stores in the State of California and elsewhere for twenty

months prior to trial, with the single exception of The Style Shop in Salinas to which defendants “once” sold their dresses, *there is no evidence whatsoever of any overlapping sale to any other store in California or elsewhere throughout the United States.* This is the more striking inasmuch as defendants listed their California accounts as including Haggarty’s, Bullock’s, May Co., Harris & Frank, Bond’s, Zukor’s, Foreman & Clark, The Emporium in San Francisco, the Marston Company and May Co. in San Diego, Gold’s and Eastern in Sacramento, etc. [R. Tr. 510]; also sales to Franklin Simon in New York City, Filene’s and Stern’s in Boston, Winkelman’s and J. L. Hudson Company in Detroit, Gimbel’s in Pittsburgh, and other leading stores throughout the nation [R. Tr. 512].

Notwithstanding these specific names or specific stores, sold by defendants, *plaintiff produced no evidence of a single sale to any one of these stores during the two year period preceding trial of the case, or at any earlier period, except a few sales to the May Co. eleven years ago.*

Furthermore, it is apparent from the evidence that plaintiff’s dresses are sold to shops in California and elsewhere, which “appeal to the more mature woman”; *not* to women’s apparel stores which “cater to the younger element” [R. Tr. 181, 182].

We, therefore, submit plaintiff’s contention of “sales to the same stores” during the entire period of the parties’ concurrent operations is totally without support in the evidence. In this connection, defendants are entitled to the presumption that since it was within plaintiff’s power to produce evidence of sales to the same stores named by defendants, plaintiff’s failure

to produce such evidence must be construed as an admission that plaintiff does *not* sell to any of the stores named by defendants (See California Code of Civil Procedure, Sec. 1963, Secs. 5 and 6; 30 Cal. Law Review 79; *Smith v. Bert M. Morris Co.*, 131 Cal. App. 2d Supp. 871).

## POINT II.

**Plaintiff Erroneously Contends That the Surname “Sachs” Is the “Dominant” or “Primary” Portion of Its Trade-Marks. Plaintiff Pays Only Lip Service to Patent Office Decisions and to the Rule That Its Three-Word Trade-Marks Must Be Considered “in Their Entirety”.**

Throughout its brief plaintiff repeatedly refers to its trade-marks as though they comprised only the single surname “Sachs” or at most “Paul Sachs” and “Don Sachs”. The fact is that plaintiff registered and uses a *three-word trade-mark*, “Paul Sachs Original” [see Exs. 1, 3 and 5 attached to the complaint]; and although plaintiff actually registered only the two-word trade-mark “Don Sachs”, the uncontradicted fact is that plaintiff has constantly and continuously used and advertised its second trade-mark as consisting of three words, “Don Sachs Original” [Pltf. Exs. 2, 4, 11, 12, 13, 51, 54, 55-62].

Plaintiff’s claim of infringement is solely predicated upon the assertion that the surname “Sachs” is the “dominant” part of plaintiff’s trade-marks. There is no basis for such a contention by plaintiff. The surname “Sachs” is not written in larger or bolder face type than the first name “Paul” or “Don”. In every case the words “Paul Sachs” and “Don Sachs” appear

in identical size and type. In many instances all three words "Paul Sachs Original" and "Don Sachs Original" appear in identical size and type in printed advertisements. Plaintiff's own exhibits clearly evidence the use of all three words in all advertising matter issued or paid for by plaintiff [see Exs. 7, 8, 9, 10, 11, 12, 13, 15, 16, 18, 19, 20, 21, 22, 23, 25, 26, 27, 28, 29, 30, 32A, 32B, 32C, 33, 34, 36, 38, 49, 51, 72, 73, 74A, 74B, 75A and 75B]. The only exceptions appear in certain advertisements when the word "*Original*" is written in script instead of block letters, as in the case of the "Paul Sachs *Original*" labels attached to the complaint [*e.g.* Exs. 1 and 3]. If any special emphasis or importance is laid upon any particular word in the trade-marks as used by the plaintiff, the single word "*original*" alone qualifies, because it is written either in block letters or in script for the obvious purpose of attracting special attention to it. At no time in no manner is the word "Sachs" alone singled out for special attention by size, color or any other differentiation from the balance of the trade-mark, *i.e.*, the Christian name "Paul" in "Paul Sachs" or "Don" in "Don Sachs".

The legal significance of this point cannot be overestimated. Plaintiff *concedes* in its brief that the Trade-Mark Act of 1946 would have prevented the registration of a surname which is "primarily merely a surname" (15 U. S. C. 1052 (e)(3)), unless the surname alone had "become distinctive of a party's goods" and was therefore registrable under 15 U. S. C. 1052(b) (See App. Op. Br. p. 51).

No evidence whatever was offered by plaintiff that the single surname "Sachs" had ever at any time

been utilized in advertising, labels, or otherwise, to distinguish plaintiff's goods. The District Court, therefore, correctly found that there were no circumstances existing in the instant case in which the surname "Sachs" alone could have been registered by plaintiff:

"It should be noted that this is a surname such as would not alone be accepted for registration" [R. 48].

Appellant next relies upon "common customs and practices" to establish dominance of the surname "Sachs", claiming dominance is "not determined altogether by the manner of presentation" (App. Op. Br. p. 51). Unfortunately for appellant, it established no custom or practice on the part of the buying public to identify either plaintiff or its products by the single word "Sachs". In fact, most of the witnesses who testified at the trial had never heard of the plaintiff corporation *or* its products—much less any popular shortened identification, such as it now seeks to analogize, *e.g.*, Macy's, Wanamaker's, Tiffany's, Stetson's, etc.

Although appellant argues that "Sachs" is "the dominant portion of appellant's trade-mark" (App. Op. Br. p. 48), it does not contend the decision of the District Court to be in any way contrary to the evidence in its express finding that the word "Sachs" was *not* dominant. In fact, appellant *concedes*:

"The District Court found as a fact that the word 'Sachs' in appellant's trade-marks had not been given any emphasis or dominance over the Christian portion of the marks, namely, 'Paul' and 'Don', as both names had been set forth in the same style and letter as the surname [R. 36]."

No useful purpose is served by appellant in referring to trade-mark cases in which only a *one-word name* was registered or in which a single word dominated all labels and advertising. Where the trade-mark registered by a plaintiff contains a single dominant word which is the primary element advertised to the general public, it is quite true that subsequent users cannot take such dominant single-word element from the trade-mark, “palm off” the subsequent product, and exonerate the fraudulent misappropriation of the dominant word of the trade-mark by adding descriptive words. Typical of such cases is the *Brooks* case, 60 Fed. Supp. 442 (cited ten times in appellant’s opening brief); the *Safeway* case, 172 F. 2d 649; the *Swarthmore* case, 81 Fed. Supp. 917; the *Dunhill* case, 44 Fed. Supp. 922; the *Kent* case, 309 F. 2d 775; the *Loraine* case, 88 Fed. Supp. 634; the *Fancee Free* case, 148 Fed. Supp. 845, and many of the other cases cited in appellant’s brief.

The point of departure between appellant’s cases and its argument is that the single word “Sachs” was never registered nor utilized by itself; it never appears alone in any of plaintiff’s labels or advertising; it is a surname which is invariably combined with either the Christian name “Paul” or “Don” in the same size of lettering, color, printing, etc.

The test of whether a surname is or is not the primary or dominant part of the trade-mark has long been established in the Patent Office and has been the subject of several decisions—all holding that when a Christian name is registered with a surname, both being given equal emphasis, size and lettering, neither the Christian name nor the surname are to be considered dominant; and registration will be freely given



to a subsequent applicant who utilizes a *different* Christian name with the *same* surname.

The Patent Office is most careful to distinguish between the trade-mark which is *in fact* primarily a surname and the trade-mark which is *not* dominated by the surname, because it also includes a Christian name of the same size and style.

In *Ex parte Andre Julian Dallieux* (1949), 83 U. S. P. Q. 262, the trade-mark "Andre Dallieux" was held registrable because the mark consisted of both a Christian name and a surname, neither of which was dominant. The Commissioner of Patents in the *Dallieux* case clearly stated the opinion of the Patent Office that a surname "dominates" the trade-mark only under the following circumstances:

"In the event the surname was *unduly emphasized* or otherwise constituted *the only significant part of the mark*, thereby amounting to 'a mere device or contrivance to evade the law and secure the registration of non-registrable words . . .'" (83 U. S. P. Q. 262).

In the District Court, the *Dallieux* case was referred to by plaintiff as "controlling authority" (Plaintiff's Trial Brief, p. 2). It is important to note that the Examiner's refusal to register the mark originally was based upon his decision that the "surname was the dominant feature of the mark and that the mark accordingly is 'primarily merely a surname' and as such should not be registered in view of section 2(e) of the Trade-Mark Act of 1946" (83 U. S. P. Q. 262). It was this decision of the Examiner which was reviewed and *reversed* by the Commissioner of Patents,

who thereby established the rule that when a surname is used with a Christian name in a trade-mark the surname is *not* deemed to be “primary” or “dominant” unless “*unduly emphasized* or otherwise constituted the only significant part of the mark” (83 U. S. P. Q. 262).

For purposes of comparison, see those decisions holding initials insufficient to prevent the trade-mark from being “dominated” by, or to be “primarily” a surname (*E.g., Sears, Roebuck and Co. v. Watson*, 96 U. S. P. Q. 360, 204 F. 2d 32, holding “J. C. Higgins” was “primarily merely a surname” and therefore rejecting registration on that ground.

Text writers have repeatedly referred to the *Dallioux* case as authority for the proposition that the use of a Christian name with a surname will normally be registrable upon the basis that the trade-mark is *not dominated by the surname* and is therefore not within the prohibition of the Act against registration of a trade-mark which is “primarily merely a surname”.

Toulmin, *Trade-mark Handbook* (1957), section 2, page 30:

“‘Andre Dallioux’ was held registrable. It was indicated such a mark might be *unregistrable*, however, if the surname *dominated* it.” (Emphasis ours)

At page 32:

“Where a surname dominates a mark the mark is unregistrable even where there are initials or a given name appended to the surname.”

Vandenburgh, *Trade-mark Law and Procedure* (1959), page 82:

“A composite mark that includes a surname that is not dominated by the surname is not rendered unregistrable by reason of the inclusion of the surname since it is not ‘primarily merely a surname.’” (Citing *Ex parte Norquist Products, Inc.*, 109 USPQ 399 (1956), and *Ex parte The B. F. Goodrich Company*, 89 USPQ 283 (1951).

In *Ex parte The B. F. Goodrich Company*, 89 U. S. P. Q. 283 (1951), the Commissioner of Patents reversed a ruling of the Examiner that the word “Goodrich” was dominant in the trade-mark, stating at page 284:

“I do not think that the examiner is justified in the present case in dissecting the applicant’s composite mark and selecting a subordinate part which is a surname as a basis for refusing registration under section 2(e) of the Act of 1946.”

In *Ex parte Perregaux* (1955), 106 U. S. P. Q. 206, registration of a trade-mark “Girard Perregaux” had been issued May 24, 1938, for watches and watch movements. Application was filed to register “Paul Perregaux” for watches in 1952. Upon appeal to the Commissioner of Patents from a denial of the latter’s application on the ground of likelihood of confusion with a prior trade-mark, the Commissioner of Patents granted registration upon the ground that there was *no likelihood of confusion*, stating at page 207:

“The only similarity between ‘Paul Perregaux’ and ‘Girard Perregaux’ is in the second component, which, as stated, is the applicant’s surname.

“Considering the circumstances surrounding the purchase of watches, the impressions created by the marks—one being more likely to be considered as a combination of surnames and the other the name of an individual—and the more recent decisional law (David & John Anderson, Ltd. v. Anderson Textile Mfg. Co., Ltd., 81 USPQ 541 [Com’r., 1949]; J. Markowitz & Son, Inc. v. Sally Mason, Inc., 72 USPQ 341 [S.D. N.Y., 1947]; Buddy Lee, Inc. v. Lee Ray Men’s Wear, Inc., 89 USPQ 555 [N.Y. Sup. Ct., 1951], I am unable to find, on this record, any likelihood of confusion.”

See also:

*Ex parte Riviera Watch Corporation*, 106 U. S. P. Q. 145 (1955);

*Ex parte Kimberly-Clark*, 83 U. S. P. Q. 437 (1949);

*Ex parte Reeves Brothers, Inc.*, 84 U. S. P. Q. 19 (1949).

Plaintiff quite properly contended in the District Court that “the Courts should not overrule the action of the Patent Office” (Pltf. Br. p. 2), and in its Opening Brief in this Court, appellant concedes the importance of decisions of the United States Patent Office:

“Although not bound, it is believed that this Court will note with interest rulings of the United States Patent Office with respect to trademarks, in view of the acknowledged expertise of the Patent Office in such matters” (App. Op. Br. p. 45).

This Patent Office construction of the Trade-Mark Act of 1946 is completely consistent with the line of

judicial decisions squarely holding a trade-mark must be considered “as a totality” or “*in its entirety*”—without dissection and without placing special emphasis upon a single word, part or portion of the composite trade-mark. In *Nestle Milk Products v. Baker Importing Co.*, 182 F. 2d 193 (1950), the Court expressly refers to the necessity that the marks be “*considered in their entirety*”. The same rule is stated in *Societe Anonyme, etc. v. Julius Wile Sons & Co.*, 161 Fed. Supp. 545, 547 (1958):

“The ordinary buyer does not stop to dissect the marks and analyze their component parts; if he is deceived it is attributable to the *mark as a totality and not normally to any particular part of it*. *Syncromatic Corp. v. Eureka Williams Corp.*, 7 Cir., 174 F. 2d 649, 650, certiorari denied, 1949, 338 U.S. 829, 70 S. Ct. 79, 94 L. Ed. 504.” (emphasis ours).

Appellant belatedly *concedes* that the single surname “Sachs” is *not* the dominant element of its trade-mark, when it contends:

“Hence, the District Court should have at least found Paul Sachs and Don Sachs to be the dominant portions of appellant’s trademark if only from an appearance standpoint” (App. Op. Br. p. 49).

Finally, appellant contends that the word “*Original*” which is part of its trade-mark “Paul Sachs *Original*” and which is imprinted on every label of “Don Sachs *Original*” (including all labels filed in the Patent Office in connection with each application for registration) is so “commonplace” as to have no trade-mark significance of any nature.

We are at a loss to follow appellant's argument. The trial court did not consider or find the word "Original" to be "the dominant portion" of either of plaintiff's trade-marks. It *did* find the word "Original" to constitute "*an element* of each of appellant's trademarks" [R. 36-37]. Having registered the entire term "Paul Sachs Original" as its trade-mark, and having continuously utilized all three words on labels and advertising, and having followed the same practice in connection with "Don Sachs Original", appellant certainly cannot and does not contend lack of evidence to support the finding of the trial court that the word "original" is "an element" of each trade-mark. The importance of such element may be large or small depending upon the psychological reaction of the purchaser. In no event can it be "totally disregarded".

Decisions of the Patent Office denying registration to a subsequent applicant who precisely duplicated both sound and appearance of a trade-mark but who contended the addition of the word "Original" *distinguished* and *excused* misappropriation of the registered trade-mark are not in point. For example, "Julette Originals" was rejected because of the prior registration of "Julette": "applicant's proposed trademark is dominated by the word 'Julette'" (*Ex parte Julette Originals*, 74 U. S. P. Q. 211, quoted in appellant's opening brief, p. 45); "La Roy Originals" was rejected because it was "the same in sound and in commercial impression" as "Le Roi" (*Le Roi Hosiery Co., Inc. v. Champion*, 114 U. S. P. Q. 135, quoted in appellant's opening brief, p. 46); "*another* Miss Connie Original" was rejected because it misappropriated plaintiff's single name

trade-mark “Connie” (*Wohl Shoe Co. v. Elder*, 90 U. S. P. Q. 144).

Appellant next argues that the word “original” is not important to appellant’s trade-mark because appellant failed to use the words “on various occasions”:

“The lack of importance of such word to appellant and its non-reliance thereon for purposes of distinction is evidenced by its failure to use such word in either its trade-mark or its corporate name on various occasions” (App. Op. Br. p. 47).

The “various occasions” referred to by appellant are *minimal* in view of the fact that almost 100 exhibits offered by plaintiff and received in evidence contain the word “original”, either in the same capital letters as “PAUL SACHS” and “DON SACHS” or in large script or italics emphasizing such word. In fact, to paraphrase appellant’s argument, the “importance of such word to appellant” and its absolute “reliance thereon for purposes of distinction” is abundantly demonstrated by the multiple advertisements received in evidence in which the words “Paul Sachs Original” and “Don Sachs Original” appear in identical size and type [*e.g.*, Pltf. Exs. 8, 9, 18, 19, 20].\*

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\*Plaintiff’s argument is misleading that Exhibits 10, 11, 12, 13, 25-30, inclusive, 32, 33, 34 and 53A to 53F reflect plaintiff’s “failure to use such word [“original”] in either its trademark or its corporate name” (App. Op. Br. p. 47). Although there appear to be no exhibits numbered and lettered 53A to 53F, the most cursory examination of the exhibits enumerated by plaintiff clearly reflects the fact that the word “original” is used together with the words “Paul Sachs” or “Don Sachs” as part of the trade-mark in Exhibits 10, 11, 12, 13, 25, 26, 27, 28, 29, 30, 32, 33 and 34 and such word is also used as part of the corporate name in Exhibits 10, 11, 12 and 13. Although plaintiff apparently elected to abbreviate its corporate name on its mailing address in Exhibits 25-33, inclusive, such exhibits included all three words “Paul Sachs Original” and “Don Sachs Original” as its advertised trade-marks.

In view of the evidence produced by plaintiff itself demonstrating its utilization and emphasis of the word "original" upon all its labels and virtually all its advertising, plaintiff is in no position to object to the finding of the trial court that the respective names "Paul Sachs *Original*" and "Don Sachs *Original*" each constituted "a single integrated trade-mark" [R. 37]. Plaintiff does not set forth at any point in its brief the entire findings of fact made by the trial court on this point and we therefore quote *verbatim* from the "Memorandum of Decision" [R. 36-37].

"In registering the trademark, 'Paul Sachs Original' plaintiff disclaimed the word, 'Original', in the following words, 'no exclusive claim being made to the word "Original" *apart from the mark as shown and described.*' (See Exhibit 1, emphasis added.) *By disclaimer, the word was not eliminated from the trademark.* As a consequence of having disclaimed the word 'Original' in the 'Paul Sachs Original' trademark and not having claimed the word at all as a part of the trademark registered as No. 708,120, plaintiff has chosen to ignore the existence of this word as a part of its trademark and has organized its case as though this word should be totally disregarded.

"The argument then proceeds to assert that the surname, 'Sachs' is dominant in each mark and that the word, 'Sachs' is also dominant in 'Sachs in California' and, therefore, there is likelihood of confusion.

"The Court finds as a fact that the word 'Sachs' in plaintiff's trademark 'Paul Sachs Original' has never been given any emphasis or predominance



over the Christian name 'Paul' and both names have always been depicted and used in the same style, size, color, lettering and appearance as the name 'Sachs'. Both names have always been given equal importance and have been displayed and shown together, which, with the addition of the word 'Original' have invariably been displayed and shown together as a single integrated trade name and trademark and substantially every use and advertisement has utilized all three words, 'Paul Sachs Original'.

"The same is true of the trademark 'Don Sachs Original'. The surname 'Sachs' in the trademark has never been given any emphasis or predominance over the Christian name 'Don' and both names have always been depicted and used in the same style, size, color, lettering and appearance with both names given equal importance. *Both names have invariably been displayed and shown together and with the word 'Original' following so that the two names and the word 'Original' have constituted a single integrated trademark.*" (Emphasis ours).

The findings and conclusions of the trial court are clearly correct and abundantly sustained by the evidence.

The following cases are illustrative of the innumerable decisions in which courts have applied the rule that the trade-mark must be considered "in its entirety" and that a single identical word or portion of the trade-mark will *not* be held to be "dominant" so as to confuse a purchaser *in the absence of special emphasis in*

*size, color or appearance upon the word of term claimed to be dominant.*

*Maas and Waldstein Company v. American Paint Corp.*, 178 F. Supp. 498 (1959) (“Plexitone” held not infringed by Flexitone”);

*Nebraska Consolidated Mills Co. v. Shawnee Milling Co.*, 198 F. 2d 36 (1952) (“Mother’s Best” held not infringed by “Mother’s Pride”);

*Eastern Wine Corp. v. Winslow-Warren, Ltd.*, 137 F. 2d 955 (“Chateau Martin” held not infringed by “Chateau Montay”);

*Seven Up Co. v. Cheer Up Sales Co.*, 148 F. 2d 909 (“Seven Up” held not infringed by “Cheer Up”);

*Avrick et al. v. Rockmont Envelope Co.*, 155 F. 2d 568 (1946) (“Sky-Rite” held not infringed by “Sky Mail”);

*Miles Laboratories, Inc. v. Henry J. Frolich*, 195 F. Supp. 256 (1961) (“Alka Seltzer” held not infringed by “Milk-O-Seltzer”);

*Vita-Var Corp. v. Alumatone Corp.*, 83 F. Supp. 214 (1949) (“Alumikote” held not infringed by “Alumatone”);

*Dietene Co. v. Dietrin Co.*, 121 F. Supp. 785 (1954);

*Solventol Chemical Products v. Langfield*, (CCA 6) 134 F. 2d 899, 903 (1957) (“Solventol” held not infringed by “Solvite”);

*Curtis-Stephens-Embry Co. v. Pro-Tek-Toe*, 199 F. 2d 407 (1952) (“Pro-Tek-Tiv” held not infringed by “Pro-Tek-Toe”);

*AnSCO Photo Products, Inc. v. Eastman Kodak Co.*, 19 F. 2d 720 (“Speedex” held not infringed by “Speedway”);

*Nestles Milk Products v. Baker Importing Co.*, 182 F. 2d 193 (1950) (“Nescafe” held not infringed by “Hycafe”).

### POINT III.

#### The Trade-Mark Act of 1946 Has Not Enlarged Plaintiff's Scope of Protection or Substantive Rights. The “Incontestability” Clause Does Not Preclude a Defense of Non-Infringement.

Plaintiff implies that the incontestability clause of the Trade-mark Act of 1946 has in some manner enlarged the scope and protection available to plaintiff's marks and that the incontestability clause, in effect, precludes the defense of non-infringement and conclusively establishes secondary meaning (App. Op. Br. pp. 71-73).

There is no legal basis for such a contention. In *Faciane v. Starner*, 230 F. 2d 732, the Circuit Court of Appeals for the Fifth Circuit ruled *adversely* to this same contention, stating at page 738:

“Appellant claims that the Lanham Act is more favorable to him and that, under the terms of that Act, he was entitled to relief under the proof made by him in the Court below.

“Substantially all which has been said, *supra*, concerning common law actions for unfair competition applies equally to this portion of the opinion. The rule is well stated in 87 C.J.S., Trade-marks, etc., §169, pp. 495-500: ‘*Registration of a trade-mark confers only procedural advantages and does not enlarge the registrant's substantive rights.*’” (Emphasis ours.)

Notwithstanding plaintiff's argument and contention that it has the exclusive right to use the surname "Sachs" because of the incontestability section of the Lanham Act, we submit that the only "exclusive" and "incontestable" right of plaintiff is to use its three-word trade-marks "Paul Sachs Original" and "Don Sachs Original". Defendants do not contest this so-called exclusive right and the trial court did *not* "indicate its doubts as to the validity of appellant's marks" or "the protection to which they are entitled" (App. Op. Br. p. 72). The incontestability clause could only be invoked as against persons claiming such three-word trade-marks to be "invalid" and asserting such third party's right to use the identical mark. No such contention arises in this case. We are *not concerned* with a situation of *conflicting identical trade-marks*. We contend that defendants' trade name, "Sachs of California", is with the exception of one word, *different* from and *dissimilar* to plaintiff's three-word trade-marks, and that there is no "confusing similarity" between plaintiff's trade-marks and defendants' trade name (see Point VI, *infra*).

Notwithstanding the stress laid by plaintiff upon other points in its brief, plaintiff *concedes* the "cardinal issue in this cause" is whether concurrent use of the trade-marks of the parties is likely to cause "confusion or mistake or deception among retail customers as to the source of origin of the goods" (Pltf. Op. Br. p. 12).

Plaintiff's point of incontestability is, by its own statement of issues, wholly irrelevant.

#### POINT IV.

**Registration of a Surname Which Does Not Stand Alone as the Dominant Part of a Trade-Mark Cannot Preclude Another From Honestly and in Good Faith Using His Personal Name in His Own Business.**

We have just shown that registration under the Trade-Mark Act of 1946 did not enlarge plaintiff's "substantive rights"; but that common law principles of unfair competition are applicable in determining whether or not trade-mark infringement has occurred through likelihood of confusion or deceit of purchasers as to source of origin (Point III, *supra*).

**A. The Common Law Is That a Man May Use His Own Surname in His Own Business, if He Uses It in Good Faith and Does Not Deceive the Public Thereby.**

The test is whether the use of the defendants' name is "reasonable, honest and fair", and whether, either in intention or result, a fraud will be practiced upon the public. Our Supreme Court in *Brown Chemical Co. v. Meyer*, 139 U. S. 540, 11 S. Ct. 625, laid down the rule at page 626:

"It is hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person *as against others of the same name who are using it for a legitimate purpose.*"

In *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 34 S. Ct. 648, 651-652 the United States Supreme Court stated:

"It is apparent that, with respect to *names or terms coming within this class, there may be proper use by others than the registrant, even in*

*connection with trade in similar goods.* It would seem to be clear, for example, that the registration for which the statute provides was *not designed to confer a monopoly of the use of surnames, or of geographical names, as such.* It is not to be supposed that Congress intended to prevent one from using his own name in trade, or from making appropriate reference to the town or city in which his place of business is located.”

The same rule has been stated and applied in California. See *Tomsky v. Clark*, 73 Cal. App. 412, 418:

“As just stated, equity will not allow a person to resort to artifice or contrivance in the use of his name as a result of which the public is deceived as to his business or products. But in such case it is not the use of a man’s own name that is condemned, it is the *dishonesty* practiced in the use of it (citing cases). *Where it appears, however, as it does here, that the party sought to be enjoined has a right to use his own name and he does so reasonably and honestly, he is not obliged to abandon the use thereof or to unreasonably restrict it, whether used in a firm or corporation, merely because some confusion may have arisen from similarity of names.*” (Emphasis ours).

- B. The General Rule Is That a Personal Surname Is in the Same Classification as Any Descriptive or Geographical Term as to Which a Strong Public Policy Precludes Monopoly.**

As stated by Vanderburgh, *Trademark Law and Procedure* (1959), at page 80:

“Like the situation with respect to descriptive and geographical marks as non-distinctive marks,

the placing of surnames in that category has a public policy background. This public policy stems from the belief that everyone is entitled to use his own name in connection with and to identify his business. The rule is applicable whether a person is doing business as an individual, a partnership or a corporation.”

It should furthermore be noted that an individual’s right to do business under his own name is more extensive than his right as stockholder, officer or director to permit a corporation to use his surname as a part of the corporate name or trade-mark. Even cases finding corporate infringement have noted this distinction. So, in *Brooks Bros. v. Brooks Clothing of California*, 60 Fed. Supp. 442, the court stated at page 449:

“A person has an inherent right to use his name in his business. And this right is recognized in the law of New York and of California, and by federal courts in cases involving trademarks and unfair competition. . . .

“So, at the outset, we are confronted with the situation that the defendant has no natural right to the use of ‘Brooks’ in its corporate name or its business. No man of that name has ever been connected with it. It adopted the name as a convenience. Consequently, as to it, the *plaintiff’s rights are not even circumscribed as they would be, if dealing with a business using the family name of a natural person who is connected with it.*” (Emphasis ours).

Similarly, in *Everest & Jennings, Inc. v. E. & J Manufacturing Co.*, 263 F. 2d 254 (1959), the court said at page 259:

“Everest & Jennings, Inc., is an arbitrary name selected as the name of a corporation and, as such corporation, is not entitled to the same equitable considerations as an individual using his own name. . . . *The mere fact a corporation is using the name of one of its shareholders does not confer the same rights the shareholder might have to the use of his own name.*”

We fully recognize the rule that not even an individual can use his own name in such a manner as to cause confusion or deceive the public, but it is clear from the foregoing authorities that the individual who is honestly doing business under his own name, whether individually or as a general partner, is entitled to substantial equitable considerations which do not pertain to corporations utilizing the name of an officer or stockholder, and the strongest public policy considerations further fortify defendants' position in this case that plaintiff should not be granted a monopoly upon the surname “Sachs”, to the exclusion of every person in the country who desires to use that surname in his own business.

Plaintiff's assertion (App. Op. Br. p. 49) of its right to “develop a family of related trade-marks” to which new members of this family may be added at will is sufficiently indicative of its intention to assert monopolistic privileges directly contrary to the public policy against such monopoly with respect to the use of personal surnames. If plaintiff's contentions be sus-



tained in this case, it will be free to add the defendant's entire name "John Sachs" as the next member of its "family."

C. Plaintiff's "Surname" Cases, When Carefully Analyzed Upon Their Individual Facts, Each Apply the Same Common Law Principles to Trade-Mark Infringement.

In *Faciane v. Starner* (C. C. A. 5), 230 F. 2d 732, the court held the same common law principles of law applicable to cases arising under the Trade-mark Act of 1946 as in cases of ordinary unfair competition, wherein the "usual concomitants" were held to be:

"*Simulation* by defendant of the name, symbols or devices of plaintiff, with the object of inducing purchase of his merchandise under the *false impression* that it originated with plaintiff; attempt by defendant to '*palm off*' his products as those of plaintiff; practices designed to *pirate* the trade of plaintiff; the employment of imitative devices to *beguile* patrons to purchase defendant's food rather than plaintiff's; or the *use of any other means incompatible with concepts of common business integrity*. The evidence fails to show that defendant had ever indulged in any of those practices, innocently or otherwise." (230 F. 2d 732, 737).

It is important to distinguish the general rule that a man can use his own name in his own business from the exceptional use for fraudulent purposes which may limit or restrict that right. In the trial court Plaintiff conceded (Br. p. 7) that "those cases are not pertinent here" in which a surname has been adopted in an individual's own business "for the express purpose of trading upon the established goodwill of another". Notwithstanding this concession plaintiff primarily relies

upon *Brooks Bros. v. Brooks Clothing of California*, 60 Fed. Supp. 442, affirmed 158 F. 2d 798, which plaintiff cites at least ten times in its opening brief. In the *Brooks* case, the trial court found *deceit* and *deliberate intent to "palm off"* defendant's goods as plaintiff's goods. The *Brooks* decision can best be understood by noting the following distinctive facts:

1. The defendant's name was not "Brooks" but was "Greenberg".

2. Defendant's registered name was "Brooks Clothing of California"; but in a deliberate effort to unfairly compete with the plaintiff, defendant *omitted* the words "Clothing of California" from its title, and upon all advertising and store signs in every state in the United States. The court expressly found "the *defendant long ago abandoned all the words of its title except 'Brooks'* in all its methods of seeking custom." (60 Fed. Supp. 442, 453).

3. The name "Brooks" as used by defendant was not intended to identify any person connected with the manufacture, sale or distribution of defendant's merchandise.

4. Defendant advertised in newspapers and upon radio solely under the name "Brooks", with the definite intention of misleading the public into believing identity existed between plaintiff and defendant, and confusion was expressly found by the court to have been generated by such misleading and false advertising (60 Fed. Supp. 442, 452-453, 455-458).

5. The word "Brooks" had become a national "household word" identifying the plaintiff's products, before defendant adopted the name and utilized it in direct competition, the court stating:

" . . . the word 'Brooks' alone, without the 'Brothers', came to be the identification mark of the plaintiff and its clothes. In fact, it is shown that in certain literary works of the middle of the century, characters were referred to as being 'Brooks' tailored or clad in 'Brooks' models" (60 Fed. Supp. 452).

In the instant case, no such public identification was pleaded or proved in connection with "Paul Sachs Original". The name "Sachs" is *not* a household word, nor can it be considered a synonym for women's clothing, as was found to be the situation in the *Brooks* case, comparable to the name "Tiffany" for jewelry; "Waterman" for fountain pens; or "Stetson" or "Dobbs" for hats. The *Brooks* case is, therefore, clearly distinguishable.

In *Hat Corporation of America v. D. L. Davis Corporation*, 4 Fed. Supp 613 (1933), 19 U. S. P. Q. 210, another case relied upon by plaintiff (App. Op. Br. p. 76), the name "Dobbs" was also held to have become a household word, Dobbs hats having been widely sold in the United States since 1908, with gross sales aggregating \$28,000,000. The court found that the name "Dobbs", like "Stetson", had become identified in the public mind and the purchasing public by its trademark "Dobbs" and that the subsequent adoption of the

name "Wm. H. Dobbs" was confusing and deceptive to the general public, particularly since the initials "Wm. H." were subordinated in advertising, the Court stating:

"The evidence was that the *plaintiff's advertising has emphasized the surname only.*"

*Celeste Frocks v. Celeste of Miami, Inc.*, 150 Fed. Supp. 604, cited and quoted by plaintiff three times in its Opening Brief is similarly distinguishable because the court expressly found each of the following facts in such case:

1. The defendant's trade-mark was "practically the same label as the trade-mark of the plaintiff".

2. The script writing of the name "Celeste" as employed by the defendant was "similarly styled to the signature shown on the plaintiff's trade-mark and trade name".

3. "Defendant's use of the said name, trade-mark and signature is calculated to cause, and has caused, and does now cause, confusion in the trade and in the public mind respecting the source of manufacture of the merchandise of the respective parties hereto".

None of the major elements controlling the *Celeste Frocks* decision are present here. It does not appear that the words "of Miami" were placed on defendant's dress label because the latter is referred to as "*practically the same label as the trade-mark of the plaintiff*", and the court expressly found that the script writing of the name "Celeste" was "similarly styled" as was its "signature". In the instant case, mere inspection of the labels utilized by plaintiff and defendants shows substantial and obvious differences in color, appearance and context.

No reasonable buyer would normally believe that a "Paul Sachs Original" dress manufactured by Paul Sachs Originals Co., a Missouri Corporation, was a dress in fact manufactured by "Sachs of California", or vice versa. On the contrary, inclusion of defendants' place of manufacture, to wit, California, points up a major difference between defendants' casual sportswear goods manufactured in California and the more formal, higher priced "Originals" manufactured by plaintiff in Missouri.

In *Richard Hudnut v. DuBarry of Hollywood, Inc.*, 127 U. S. P. Q. 486, cited three times in Appellant's Opening Brief, the trade-mark infringement was plainly held to be the result of deliberate fraud, misleading advertising and confusion. The facts of the case showed that plaintiff had registered and utilized the trade-mark "DuBarry" for more than 60 years; \$370,000,000 worth of its products had been sold in the United States; \$55,000,000 had been spent in advertising during the last 25 years, and a large number of products were manufactured by it in the soap, perfume and cosmetic business. Defendant "DuBarry of Hollywood, Inc." was incorporated by four persons respectively named John Ishkanian, Arnold Colt, Ann Glatzer and Sara Grossman. The court found at page 487:

*"No one bearing the surname 'DuBarry' was ever an officer, director or employee of the defendant corporation.*

\* \* \*

*"The defendants' products and trade paper advertising are conspicuously labeled with the trade-mark and trade name 'DuBarry' . . . often printed in substantially the same script type in which it is*

*displayed by the plaintiff; defendants' trade-mark and trade name 'DuBarry' is often accompanied by the representation of a crown similar to that used by the plaintiff; and it is also frequently used in conjunction with the words 'famous', 'genuine', 'original'. Plaintiff is the only 'genuine', 'original', 'famous' DuBarry company and defendants' characterization of itself by these words falsely represents that it is the plaintiff.*" (Emphasis ours)

Plaintiff also refers to *Sullivan v. Ed Sullivan Radio and T. V. Inc.* (1956), 1 App. Div. 2d 609, 110 U. S. P. Q. 106, which is simply another example of applying common law rules of protection against fraud and deception. The plaintiff Ed Sullivan had been nationally known for 20 years, appearing in widely syndicated columns throughout the country and before audiences estimated at over 50 million on his television program "The Ed Sullivan Show" which was broadcast in Buffalo, New York, over the facilities of station WBEN-TV. He had commercially exploited the good will attached to his name by endorsing particular brands of television sets and intended "to continue making such endorsements". Defendant engaged in the business of selling radio and television sets in Buffalo, New York, under the name "Ed Sullivan Radio and T. V. Inc." The court held at page 106:

" . . . it is undisputed that the name 'Ed Sullivan' is automatically identified by the general public with appellant *alone*, insofar as radio and television are concerned." (Emphasis the Court's).

In *Harvey Machine Co., Inc. v. Harvey Aluminum Corp.* (1957), 9 Misc. (N. Y.) 2d 1078, 113 U. S. P. Q. 437, cited in plaintiff's brief, the plaintiff corpora-

tion had been engaged in business under the name of "Harvey Machine Co" since 1916; had done business under the name of "Harvey Aluminum" since shortly after 1942, and in 1952 had incorporated "Harvey Aluminum Sales, Inc.", the gross sales aggregating \$21,000,000 annually. In 1951 the defendant Harvey Richter incorporated "Harvey Machine Shop Specialists, Inc.", and in 1953 "Harvey Aluminum Corporation". The court enjoined the use of both names, stating at page 438:

"Defendants have adopted and are using corporate names closely similar to plaintiffs' names and mark. *Such use has resulted in deception and confusion*". (Emphasis ours).

Both the *Sullivan* and *Harvey* cases thus reflect actual "palming off" with positive evidence in the *Harvey* case of resulting "deception and confusion". No such evidence appears in the case at bar.

In *Chester Barrie, Ltd. v. Chester Laurie, Ltd.*, 189 Fed. Supp. 98 (repeatedly cited in App. Op. Br. pp. 24, 39, 56, 72, 76), the defendant Samuel Kozinsky was not using his own personal surname but deliberately adopted a corporate name, Chester Laurie, Ltd., similar to plaintiff's name, Chester Barrie, Ltd., for the purpose of "simulating plaintiff's trade-mark". The court found as a fact this evidence of defendant's intention "to appropriate a competitor's customer" and "to trade on his good will" (189 Fed. Supp. 102). The court furthermore found "evidence of actual confusion among persons engaged in the retail clothing business" (189 Fed. Supp. 102).

In *Kay Dunhill, Inc. v. Dunhill Fabrics*, 44 Fed. Supp. 922 (quoted in App. Op. Br. pp. 32, 41, 49, 68),

plaintiff was originally incorporated as Dunhill Frocks, Inc., and later changed the name to Kay Dunhill, Inc., the latter name being trade-marked. Separate Kay Dunhill departments existed in 23 different stores throughout the country, with substantial advertising in fashion magazines and daily newspapers and on radio. Although manufacturing dresses, plaintiff gave names to the fabrics purchased by it which were generally associated with, and included all or part of its trade name. Defendants also manufactured fabrics to which they attached the name "Dunhill" and selected names for their fabrics which were comparable to the fabric names selected by plaintiff. Stores which purchased dresses manufactured from defendants' fabrics advertised such dresses in such a manner as to cause confusion in source and origin, the court stating at page 927:

"I regard the inference as inescapable that defendant was the origin of the statements contained in the advertisements as to what were the fabrics from which the dresses were made. Moreover, as I see it, the advertisements were capable of being interpreted as meaning to say, and were *designed to convey the impression*, that the dresses had been manufactured by a concern having the word 'Dunhill' in its name, *without giving the complete or exact name.*" (44 Fed. Supp. 927).

\* \* \*

"Plaintiff suffered injury because in the market purchasers of dresses were either *mised* into believing that dresses produced from fabrics of defendant had been manufactured by plaintiff or were *confused* on the subject or that, by means of hang tags or advertising or by other means emanating



from and resulting from conduct of defendant, dresses made from fabrics of defendant were sold or *palmed off as dresses made by plaintiff.*" (44 Fed. Supp. 929, emphasis ours).

In *Williamson-Dickie Manufacturing Co. v. Davis Manufacturing Co.*, 251 F. 2d 924 (quoted four times in App. Op. Br.), plaintiff sued for infringement of his trade-mark "Dickie's" caused by defendant's confusing use of the name "Dickie Davis", both names being used on boys' clothing. Apparently, the major defenses asserted unsuccessfully in that case were that plaintiff's trade-mark was invalid and that "Dickie" was "primarily merely a surname". The court held that "Dickie" was "primarily a diminutive of the name Richard" (251 F. 2d 926). The court found that plaintiff and defendant were in *direct competition*, one with the other. There was no serious contention made by defendant that the marks were dissimilar.

The foregoing cases upon which plaintiff has placed such great emphasis, wherever relevant, are in fact in point for defendants and *plaintiff has cited no case in which an individual doing business under his own surname, coupled with a geographical reference identifying source and origin of product, has been precluded or enjoined because of a prior trade-mark which included the same surname coupled with a Christian name given equal prominence.*

If plaintiff's cases are carefully read and analyzed, the conclusion is inevitable that notwithstanding some dicta upon which plaintiff relies, there is no rule or legal principle which will permit plaintiff to monopolize the surname "Sachs" as against an individual who

is honestly and legitimately attempting to carry on his own business under his own name without confusing or misleading advertising and without attempt to “palm off” his goods or trade on the good will of another.

#### POINT V.

The Legal Test of “Likelihood of Confusion” Is Not Whether the Merchandise of the Respective Parties Is “Capable of Emanating From the Same Source” but Whether an Ordinarily Discriminating Purchaser Would Purchase Defendants’ Product in the Belief She Was Purchasing Plaintiff’s Product. The Test Is Not Possibility but Probability of Confusion.

The cases cited by plaintiff do not sustain its contention that “the criterion is whether the respective merchandise *could emanate* from a single source of origin” (App. Op. Br. p. 12, lines 9-10). Such a criterion would involve mere *possibility*, not *reasonable probability*, that a purchaser would confuse the identity of the manufacturer. The true test is whether there is “likelihood of confusion”; a test earlier recognized in appellant’s opening brief (p. 3):

“The cardinal issue in this cause is whether or not the concurrent use of the trade-marks of the parties upon the respective merchandise, namely women’s ready-to-wear dresses is *likely to cause confusion or mistake or deception* among retail customers as to the source of origin of the goods. The same issue relates to the trade names used by the parties for identifying their dress manufacturing businesses.” (emphasis ours).

On this issue the trial court made specific findings of fact adverse to plaintiff which are abundantly sustained by the evidence [R. 49-50].

*“From the standpoint of sound when orally pronounced the trade marks are not confusingly alike. They are not confusingly similar in appearance. There is no likelihood of confusion between plaintiff’s marks ‘Paul Sachs Original’, ‘Don Sachs Original’ and the registered trade-mark ‘Don Sachs’ with defendants’ trade-mark and trade name ‘Sachs of California’.”*

\* \* \*

“No critical questions of law are presented in the case at bar. This decision rests upon determination of questions of fact . . .”

\* \* \*

*“The only conclusion which the evidence in this case enables the court to reach is that . . . the trade-marks are clearly distinguishable by their customers and there is no likelihood of confusion from the use of the trade name and trade-mark Sachs of California’ by the defendants.”* [R. 49-50].

It is well settled in this circuit that factual findings of this nature will not be reversed, even though “reasonable minds might differ”. As stated in *Oriental Foods v. Chun King Sales*, 244 F. 2d 909, 915:

“It is entirely possible that different triers of fact might come to different conclusions on these facts but we cannot say it was clearly erroneous for the District Court here to come to the conclusion that no unfair competition existed. Such a judgment is supported by the court’s findings, and they in turn are supported by the evidence.”

So also in,

*Audio Fidelity, Inc. v. High Fidelity Recordings, Inc.*, 283 F. 2d 551, 557:

“Ordinarily such a determination is one of fact, where it is one upon which reasonable minds might differ. Under such a circumstance we could not interpose our judgment for that of the trial court.”

In most cases, plaintiff’s brief *omits* discussion of the basic facts which led to a finding of infringement or unfair competition in any particular case. As stated in *Harold F. Ritchie, Inc. v. Chesebrough-Pond’s Inc.*, 281 F. 2d 755, 757 (1960):

“Each case alleging trademark infringement must be judged on its own facts, and citation of authorities is not very helpful, except insofar as they show the general pattern. *LaTouraine Coffee Co., Inc. v. Lorraine Coffee Co., Inc.*, 2 Cir., 157 F. 2d 115, 117, certiorari denied 327 U. S. 771, 67 S. Ct. 189, 91 L. Ed. 663; *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F. 2d 144, 147.”

We shall, therefore, attempt to define the factors which must ordinarily be found to be present in order to find infringement (Point VI, *post*).

## POINT VI.

In Determining Whether or Not Trade-Marks Are Confusingly Similar, They Must Be Considered "As a Whole", With Due Regard to Several Factors:

(1) Similarity in Appearance, Sound and Contexts;

(2) Degree of Care Likely to Be Exercised by Purchasers;

(3) Colorable Imitation in Labels or Advertising;

(4) If Defendant Has Acted Honestly and Innocently or Has Deliberately Adopted Another's Trade Name With the Intent of "Palming Off", Deceiving or Confusing Customers.

In *Avrick et al. v. Rockmont Envelope Co.*, 155 F. 2d 568 (1946), plaintiff ("Sky-Rite") sued defendant ("Sky Mail") for infringement of trade-mark on air mail stationery. The court held non-infringement, stating the following:

"Restatement has however listed the following as important factors entering into the equation: '(a) the degree of similarity between the designation and the trade-mark or trade name in (i) appearance; (ii) pronunciation of the words used; (iii) verbal translation of the pictures or designs involved; (iv) suggestion; (b) the intent of the actor in adopting the designation; (c) the relation in use and manner of marketing between the goods or services marketed by the actor and those marketed by the other; (d) the degree of care likely to be exercised by purchasers.' 3 Torts A.L.I., Sec. 729".

*“It is the total effect produced by the designation in the mind of the ordinary purchaser, exercising due care in the market place.”* (155 F. 2d 568, 572.)

In *Nebraska Consolidated Mills Company v. Shawnee Milling Company*, 198 F. 2d 36 (1952), the Court of Appeals for the Tenth Circuit sustained the finding of the trial court that the brand name “Mother’s Pride” was “not sufficiently similar to the brand name “Mother’s Best” to be likely to deceive an ordinary buyer exercising ordinary intelligence and observation in business matters”. The appellate court said at page 38:

“In *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 10 Cir., 107 F. 2d 699, 704, we stated the test for determining whether confusion of goods is likely to result, as follows:

*‘The test is whether the similitude in the labels would probably deceive a purchaser who exercises ordinary prudence, not the careless buyer who makes no examination.’”*

In *Eastern Wine Corporation v. Winslow-Warren, Ltd.*, 137 F. 2d 955, the plaintiff had sold wines under the name of “Chateau Martin” for many years prior to the time that defendant commenced the sale of wine in a similar bottle under the name of “Chateau Montay”. The trial court issued an injunction, holding the names were so similar “in sound and appearance . . . as to make confusion of the two probable” (137 F. 2d 957). Evidence was introduced that an investigator had asked for defendant’s product in two retail stores and was offered plaintiff’s product; that bottles of

plaintiff's product were displayed in one retail store on top of cases of defendant's product and that an officer of one wholesaler testified his salesmen had attributed the decline in plaintiff's sales to the fact that defendant's product was on the market and was "similar in type of package and very close in name". Upon appeal, the Circuit Court of Appeals *reversed* upon the following grounds:

"We approach the case at bar having in mind the basic common law policy of encouraging competition and the fact that the protection of monopolies in names is but a secondary and limiting policy.

"Although the plaintiff made diligent efforts, through an investigator, to find persons who had actually been misled by the alleged confusion of the two names, the evidence on that score which plaintiff obtained was so trifling and unconvincing that the trial judge found that 'the evidence as to actual confusion and actual damage is too speculative to support a judgment for accounting.'

\* \* \*

". . . we believe there was no such probability [of confusion]. In so concluding, we are indeed confirmed by the inability of plaintiff, despite its diligence, to procure satisfactory evidence on that issue. The issue in such a case as this is '*whether an appreciable number of prospective purchasers of the goods . . . are likely to be confused*. 'That a few particularly undiscerning prospective purchasers might be so misled is not enough.' " (Quoting Restatement of Torts, § 728, Comment a.)

In *American Automobile Association v. American Automobile Owners Association* (1932), 216 Cal. 125, the court stated the test applicable to determine “likelihood of confusion” as follows:

“Would a person exercising that care, caution and power of perception which the public may be expected to exercise in the matter which it has in mind, mistake one of said emblems for the other?” (216 Cal. 131).

In *Southern California Fish Company v. White Star Canning Company*, 45 Cal. App. 426 (187 Pac. 981), the court stated:

“. . . a resemblance which would deceive only an indifferent or careless purchaser gives no right of action.”

Although *men's* clothing and military uniforms may be strikingly similar in style, fabric and appearance (*e.g.*, *Brooks Bros. v. Brooks Clothing, etc.*, 60 Fed. Supp. 442), the exact opposite is true of *women's* apparel, in which the styles, fabrics, and general appearance of women's dresses is noticeably dissimilar. The Trial Court has found upon abundant evidence that women shoppers constantly exercise their personal taste and judgment in determining whether or not a particular dress fits their particular individual needs [Rec. 45, 46]. This careful selection exercised by women buyers distinguishes the case at bar from the “mass-produced low-priced articles” in which no personal taste is required or exercised.



So, in *Societe Anonyme, etc. v. Julius Wile Sons & Co.*, 161 Fed. Supp. 545 (1958), the court said at page 547:

“. . . As distinguished from mass produced low priced articles, the selection and purchase of a creme de menthe cordial generally involves an exercise of personal taste and purchasers of such liqueurs are apt to buy with a greater degree of sophistication and care than might be true in their purchase of other merchandise. Such a consideration is always relevant in appraising the likelihood of confusion. See *LaTouraine Coffee Co. v. Lorraine Coffee Co.*, 2 Cir., 157 F. 2d 115, 124 (dissenting opinion), certiorari denied 1946, 329 U. S. 771, 67 S. Ct. 189, 91 L. Ed. 663; Restatement, Torts § 729(d), comment g (1938); 3 Callmark, Unfair Competition and Trademarks § 81.2(a) (2 ed. 1950).”

“Each of the two marks now before the court, ‘Freezomint’ and ‘Frappemint’ must, of course, be considered as an entire unit. The ordinary buyer does not stop to dissect the marks and analyze their component parts; if he is deceived it is attributable to the *mark as a totality and not normally to any particular part of it*. *Syncromatic Corp. v. Eureka Williams Corp.*, 7 Cir., 174 F. 2d 649, 650, certiorari denied, 1949, 338 U. S. 829, 70 S. Ct. 79, 94 L. Ed. 504.”

At page 548, the court further stated:

“Though precedents are not particularly helpful in this area it is of interest to note that the designation ‘Clor-Aids’ was held not to infringe ‘Clorrets’ and the word ‘Syrocol’ not to infringe ‘Chera-

col'. *American Chicle Co. v. Topps Chewing Gum*, 2 Cir., 1954, 210 F. 2d 680; *Upjohn Co. v. Schwartz*, 2 Cir., 1957, 246 F. 2d 254. The two marks in the instant case cannot be said to possess greater similarities than those discussed in the cases above where infringement was found lacking."

In *E. & J. Gallo Winery v. Ben R. Goltsman & Co.*, 172 Fed. Supp. 826 (1959), there were before the court two wine labels which were ostensibly very similar, *e.g.*, plaintiff ("Thunderbird"—"grape wine with natural pure flavors") and defendant ("Thunderbolt"—"grape wine with pure natural flavors"). The court found no infringement, and stated at page 829:

"This Court further finds that there is no reasonable likelihood that the wine-buying public<sup>2</sup> will be deceived or confused by the two trademarks in question."

"<sup>2</sup>The evidence in this case makes it clear that the wine-buying public—insofar as their selection and purchase of wine is concerned—is a highly discriminating group."

It is noteworthy that in both the *Gallo Winery* and *Julius Wile* cases, *supra*, the court referred to the "personal taste" and discrimination which would ordinarily be exercised by purchasers who would readily distinguish between both the trade-marks and the products. Similar "selectivity" has been found to be exercised in connection with the purchase of watches in *Ex parte Perregaux*, 106 U. S. P. Q. 206 (1955), in which the Commissioner of Patents held there was no likelihood of confusion between two trademarks re-

spectively designated “Girard Perregaux” and “Paul Perregaux”.

In *Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co.* (1952, C. C. A. 8), 199 F. 2d 407, the court held the trade-mark “Pro-Tek-Tiv” was not infringed by defendants’ trade-mark “Pro-Tek-Toe”, the court holding that the question of infringement must be decided upon the same principles whether under the statute or common law, stating at page 414:

“But although the registration is valid and a secondary meaning was established for the mark ‘Pro-Tek-Tiv’, it does not necessarily follow that plaintiff was entitled to a finding or judgment of infringement. . . . *Both the statute and the law of unfair competition confer and protect only the ultimate objective of both—the right to be free from the unfair competition of one who seeks by the use of a similar mark to palm off his products as those of the owner of the trade-mark. \* \* \* Defendants selected their mark and used it in good faith without knowledge of plaintiff’s trade-mark or intent to interfere with or injure plaintiff’s business or reputation. \* \* \* Defendant was not using the mark in such a manner as to make it appear that its product was that of plaintiff. We find no basis in this record for a finding of infringement or unfair competition.* *California Fruit Growers Exch. v. Sunkist Baking Co.*, 7 Cir., 166 F. 2d 971; *Federal Telephone & R. Corp. v. Federal Television Corp.*, 2 Cir., 180 F. 2d 250; *Brown & Bigelow v. B. B. Pen Co.*, 8 Cir., 191 F. 2d 939; *Majestic Mfg. Co. v. Majestic Elec-*

tric App. Co., 6 Cir., 172 F. 2d 862; Hiram Walker & Sons v. Penn-Maryland Corp. 2 Cir., 79 F. 2d 836.” (Emphasis added.)

In *Solventol Chemical Products v. Langfield*, 134 F. 2d 899, 903, the trade-mark “Solventol” was held *not* to have been infringed by the similar trade-mark “Solvete”, the court stating:

“The suffixes “vite” and “tol” distinguish one combination from the other and give an identifying character to the trade designation which makes it unlikely that one trade-mark could, with the exercise of ordinary care, be mistaken for or be confused with the other. They look unlike, are spelled differently, and are phonetically dissimilar.’”

In *Maas & Waldstein Company v. American Paint Corp.*, 178 Fed. Supp. 498 (1959), the plaintiffs had registered the trade-mark “Plextone” under the Lanham Act for many years prior to the defendant’s adoption of the mark “Flexitone”, both products relative to color paints. The court held *non-infringement* at page 501:

“The evidence of the instant case furnishes no demonstrable likelihood of defendant’s misleading the purchasing public to believe it is obtaining a Plextone product when it is buying a Flexitone product.”

\* \* \* \* \*

“The exercise of ordinary care by a purchaser of defendant’s product would obviate all possibility of confusing it with plaintiffs’.”

In *Miles Laboratories, Inc. v. Henry J. Frolich*, 195 Fed. Supp. 256 (1961), the plaintiff-owner of the trade-

mark “Alka-Seltzer” sued the defendant who was utilizing the trade-mark “Milk-O-Seltzer” for alleged infringement, claiming confusing similarity. The court held non-infringement, stating:

“The only genuine similarity between the marks here is the use of the word ‘seltzer’ as the last syllable of both.

\* \* \* \* \*

“Plaintiff suggests that unless relief is granted, defendant may change his packaging so as to copy plaintiff. It will be soon enough to decide such a case of ‘palming off’ when it arises.

\* \* \* \* \*

“Plaintiff points out that both products might be sold to the same or similar customers and that these customers probably do not exercise particular caution in purchasing. Although the purchasers of of patent medicines are ‘casual’ rather than ‘discerning,’ *Grove Laboratories, Inc, v. Approved Pharmaceutical Corporation, D.C.N.D.N.Y. 1957, 149 F. Supp. 86, 90; Callman, supra, vol. 3, pp. 1383-1392, this factor is not decisive unless the names are confusingly similar.*”

Courts have frequently commented upon the failure of a plaintiff to produce substantial evidence of actual confusion where competing products have been used in the same territory *Mishawaka Rubber & Woolen Mfg. Co. v. Panther-Panco Rubber Co., Inc., 153 F. 2d 662, 665 (1946); Maas & Waldstein v. American Paint Corp., 288 F. 2d 306 (1961))*.

Even where a plaintiff has produced some slight evidence of confusion or mistake, this has been held to be immaterial (*Avrick, et al. v. Rockmont Envelope*

Co., 155 F. 2d 568 (1946); *Nebraska Consolidated Mills Company v. Shawnee Milling Company*, 198 F. 2d 36 (1952); *Eastern Wine Corporation v. Winslow-Warren, Ltd.*, 137 F. 2d 955; *S. C. Johnson & Son v. Johnson* (1949), C. C. A. 2, 175 F. 2d 176.

It is furthermore significant that defendants acted honestly in the adoption of defendant John Sachs' name and in designating the place of manufacture as part of their business firm name. Notwithstanding plaintiff's position that it is "not requisite to show actual confusion" (App. Op. Br. p. 67), the cases principally relied on by plaintiff show "a deliberate attempt to confuse and mislead the public into believing that the product was sponsored or manufactured" by the defendant (e.g., *MacSweeney Enterprises v. Tarantino*, 106 Cal. App. 2d 504, 514, cited in App. Op. Br. p. 67). See also Point IV, *supra*, and Point VII, *infra*, in which the same factual elements of deliberate or fraudulent intent, appear as the actual basis of the respective decisions cited by plaintiff.

As we have shown, the converse is true when the defendant has acted innocently, with no intent to confuse or deceive customers (see *Curtis-Stephens-Embry Co. v. Pro-Tek-Toe, etc.* (1952), C. C. A. 8), 199 F. 2d 407, 414; *Avrick, et al. v. Rockmont Envelope Co.*, 155 F. 2d 568; *Faciane v. Starner* (C. C. A. 5), 230 F. 2d 732).

In *Palmer v. Gulf Publishing Co.*, 79 Fed. Supp. 731 (1948), Judge Yankwich held that plaintiff's trademark registration on the magazine title "World Petroleum" was not infringed by a subsequent use of the

title "World Oil", quoting with approval from the following cases:

*Collegiate World Publishing Co. v. DuPont Publishing Co.*, 14 F. 2d 158, 160, wherein the name "College Humor" was held not infringed by "College Comics";

*Fawcett Publications v. Popular Mechanics*, 80 F. 2d 194, wherein the title "Popular Mechanics" was held not to have been infringed by the title "Modern Mechanics"; and

*McGraw-Hill Publishing Co. v. American Aviation Associates*, 117 F. 2d 293, wherein the title "Aviation" was held not to have been infringed by the defendant's title "American Aviation".

Although the last cited cases involve so-called "periodical trade-marks", we submit that the purchasers of such periodicals customarily use their own personal taste, discrimination and judgment in selecting a periodical which is purchased from a newstand or other outlet. The reasoning in these cases closely approximates the reasoning of the courts and the Patent Office wherever customers are expected to exercise "that care, caution and power of perception which the public may be expected to exercise". Furthermore, the "periodical trade-mark" cases have been cited with approval in non-periodical cases in this very circuit and by this Court. For example, *Palmer v. Gulf Publishing Co.*, 79 Fed. Supp. 731, is cited with approval in *Sunbeam Lighting Co., et al. v. Sunbeam Corporation*, 183 F. 2d 969 (1950), wherein this Court said at page 973:

"We commend the opinion as a careful study of the broad issues of this case buttressed by many authorities and apt quotations therefrom."

In the *Sunbeam* case, the trial court had enjoined use of plaintiff's registered and common law trade-mark "Sunbeam". This Court *reversed*, subject to the following limitations (183 F. 2d 974): (1) that defendant could not use the word "Sunbeam" "*with a script resembling or suggestive of the script used by plaintiff-appellee*" and (2) defendant could not use the *complete two-word names* "Sunbeam Master" or "Sunlight Master" first adopted and used by plaintiff. This Court held that defendant's use of the word "Sunbeam" would not otherwise be enjoined.

It is noteworthy that the only distinction between the names of the parties was that plaintiff's name was "The Sunbeam Corporation"; defendant's name was "Sunbeam Lighting Company"; and it was the defendant's practice to place upon its articles, advertising and catalogs the following designation, "Sunbeam Lighting Company, Los Angeles, Cal." and this practice was held to be proper and was sustained by this Court as non-infringement of plaintiff's trade-mark (183 F. 2d 972).

The two latest cases which have come to our attention are *Societe Comptoir de l'Industrie Cotonniere, Etablissements Boussac v. Litwin & Sons, Inc.*, 130 U. S. P. Q. 359 (1961) in which the name "Christian Dior" was held not infringed by "Maison d'Or"; and *Wincharger Corp. v. Wiancko Engineering Co.* (C. C. Pa. 1962), 133 U. S. P. Q. 378, 301 F. 2d 927 in which the name "Winco" was held not infringed by "Wiancko"; notwithstanding similar sound, spelling and appearance. Each of these late cases involved registration of trade-marks in the same class of goods salable to the same customers in the same market.



## POINT VII.

### Plaintiff's Cases Involving Deliberate Misappropriation of a Fanciful Trade-Mark Are Not in Point.

We have heretofore considered some of the cases principally relied upon by plaintiff in which surnames or Christian names (when *not* combined in a single trade-mark) have been held to have been deliberately and fraudulently misappropriated (*e.g.*, *Brooks, Dobbs, Sullivan, Harvey*, etc., see Point IV, *C. supra*, pp. 37-46;

We now turn to other cases cited by plaintiff in its appeal brief in which the trade-marks are truly fanciful but the finding of infringement was based upon deliberate misappropriation of the fanciful mark.

In *Barbizon Corp. v. Hollub*, 41 N. Y. Supp. 2d 117 (cited in App. Op. Br.), one trade-mark was not merely similar *in part* to the other—the trade-mark “Barbizon” was *appropriated in its entirety* by defendants, the court holding that confusion of source would necessarily follow. Further, the garments of both parties could be purchased by the *same retail customer*, a factor which in and of itself distinguishes that case from the case at bar. It is obvious that no personal surname was involved and that no effort was made to distinguish defendants’ trade-mark from plaintiff’s. The infringing mark was identical.

In *Carlisle Shoe Co. v. Societe Anonyme*, 278 F. 2d 519 (quoted in App. Op. Br. p. 32), the single word “Mademoiselle” constituted appellant’s entire trade-mark and was held to be dominant in the applicant’s trade-mark because the additional words “Le Gant” were displayed *less prominently* than the word

“Mademoiselle” and the latter trade-mark had been appropriated in its entirety by defendants. In the *Mademoiselle* case the following factors were all present and totally distinguish that case from the case at bar:

- (1) Plaintiff’s trade-mark consisted of one word only, which was appropriated in its entirety.
- (2) The additional words added by defendants were in much smaller type and “displayed less prominently” both in the trade-mark and in advertising.
- (3) Defendants deliberately adopted plaintiff’s trade-mark as a part of their trade-mark for the purpose of “trading upon” plaintiff’s good will.

In *Chips 'N Twigs, Inc. v. Blue Jeans Corp.*, 146 Fed. Supp. 246 (quoted in App. Op. Br. p. 24), plaintiff manufacturer of “Chips” blue jeans secured an injunction against defendant who manufactured “Blue Chips” blue jeans. Defendant’s merchandise was sold at a much lower figure; was of substantially inferior quality; and was capable of being sold to the same retail customers. The court held defendant’s name to be deceptively similar and to have been adopted with the *deliberate purpose of “palming off” inferior goods*. Of course, no personal surnames were involved.

In *Jays’ Inc. v. Jay-Originals, Inc.*, 76 U. S. P. Q. 238 cited in appellant’s opening brief, page 48, the court found as a fact that the defendant had actual notice of plaintiff’s name “Jays” and of the fact that plaintiff used the name “Jays” and “Jay” in its advertising and publicity; furthermore, that there was actual competition between plaintiff and the retailers to whom defendant sold its merchandise. In addition,

there was evidence of actual confusion in that mail sent to one party was delivered to another. Finally, the court noted that defendant had not used a personal surname but had arbitrarily selected one of the names used by plaintiff to which secondary meaning had attached:

“It is to be noted that the name ‘Jay’ is not the real name of anyone connected with the defendant corporation but was a name arbitrarily chosen.”  
(76 U. S. P. Q. 240).

In *National Design Center, Inc. v. 53rd Street Design Center, Inc.*, 203 N. Y. Supp. 2d 517 (cited in App. Op. Br. p. 34), plaintiff’s and defendants’ places of business were located almost directly opposite each other on the same street in New York City and each featured furniture, bric-a-brac and allied products; and the court found the words, “Design Center” to have been adopted by the defendants with the *deliberate intention* of harming the plaintiff and trading upon plaintiff’s good will.

In *Lorraine Manufacturing Co. v. Lorraine Knitwear Co., Inc.*, 88 Fed. Supp. 634 (quoted in App. Op. Br. p. 68), the labels were found by the court to have been so similar as likely to deceive purchasers because the *only difference* between plaintiff’s registered trade-mark and defendant’s label being the omission of one letter “r” in the word “Lorraine”.

In *Safeway Stores, Inc. v. Dunnell*, 172 F. 2d 649 (quoted in App. Op. Br. p. 40), plaintiff’s single word “Safeway” was broken into two words as “Safe Way” by defendants; both were blocklettered in the same manner; and the court held the marks to be “substantially identical”.

In *Swarthmore Classics, Inc. v. Swarthmore Junior*, 81 Fed. Supp. 917 (quoted in App. Op. Br. pp. 31, 40, 68, 77), the court found neither plaintiff nor defendants used the word "Swarthmore" "in its geographic denotation"; both used it for its "young college girl" connotation (81 Fed. Supp. 919; finding 14), both plaintiff's and defendants' goods were "bought by common retail purchasers" [Finding 21]; plaintiff's and defendants' offices were adjoining on Broadway [Finding 10]; mail was misdirected prior to and subsequent to the time such adjoining offices were established [Finding 11]. The court concluded that one trade-mark was a colorable imitation of the other.

In *Youth Form Co. v. R. H. Macy & Co., Inc.*, 153 Fed. Supp. 87 (quoted in App. Op. Br. p. 30), notwithstanding identity in sound, spelling and appearance, defendant was only enjoined from utilizing the two words "Youth Form" *in script* because plaintiff's trade-mark "Youthform" was "written in script as one word" (153 Fed. Supp. 94). Defendant was *not* enjoined from utilizing the two words "Youth Form" in *block letters*:

"Defendant in all areas may use the two words 'Youth Form' and the three words 'Miss Youth Form' in block letters as such words will not cause such confusion in the trade as to entitle plaintiff to an injunction." (153 Fed. Supp. 95).

See also *Richard Hudnut v. Du Barry of Hollywood, Inc.*, 127 U. S. P. Q. 486, 487; *Brooks Brothers v. Brooks Clothing of California*, 60 Fed. Supp. 442 and the other cases cited by appellant heretofore distinguished in our brief, Point IV, *supra*, in all of which the trial

court found deliberate confusion or fraudulent intent in defendants' advertising as the basis of the judgment for unfair competition entered in the respective cases cited by plaintiff.

### POINT VIII.

**Defendants' Business Name, "Sachs of California",  
Consists of a Combination of Three Words  
Which Has Acquired Secondary Meaning Solely  
Identifying Defendants and Their Merchandise.**

Appellant insists on dissection of both plaintiff's and defendants' marks. Of course, the term "of California" is "inherently incapable of distinguishing appellees' dresses" (App. Op. Br. p. 53) only if it is divorced from the balance of defendants' actual trade name "Sachs of California".

Plaintiff seeks to have this Court disregard two-thirds of defendants' trade name "Sachs of California" upon the ground that the term "of California" is "without trademark significance" (App. Op. Br. p. 53). This contention is made notwithstanding the fact that defendants' full business name "Sachs of California" has been utilized in every label, hang-tag, order form, letter-head, envelope, calling card and advertisement prepared or used by defendants [See Deft. Exs. A, B, C, D, E, F, G, H, I, K, R, S, and T]. Similarly, the entire name is used with all three words in capital letters in the various sales solicitations prepared by the various national buying services through which defendants sell a large proportion of their merchandise [*e.g.*, Defts Exs. L, L-1, L-2, M, N, O].

Plaintiff adopts the test of "a dominant feature of a trade-mark" as "that which is most noticeable and most

unavoidably attracts the attention of the public” (App. Op. Br. p. 53, quoting Callman, *Unfair Competition and Trade-Marks*, p. 1438]. The uncontradicted evidence of Mr. Woodard and Mr. Weishar, and defendants’ other witnesses, is that the words “of California” have achieved extraordinary value due to the modes of advertising and promotion of merchandise manufactured in California. Most of the members of the California Fashion Creators utilize the name to identify the origin of their products and to attract the public’s attention to the State of California as the source of their goods [R. Tr. 366, 368, 476]. Mr. Woodard testified *without contradiction* that “the California market in itself has always stood for something unique in the apparel, and in the color, and in the design, and in the styling of the clothes which we make out here; I don’t think there is any question about the fact that we have obtained world-wide recognition of the California market” [R. Tr. 347]. Mr. Woodard further testified that “the purpose of our association” is “to establish in the minds of the general public throughout the United States the special, unique and distinctive nature of the California market” [R. Tr. 348]. Large Eastern retail department stores in Detroit, Chicago, and elsewhere feature California-made merchandise and hold “a California promotion in their stores” [R. Tr. 351]. In 1961, “California Fashion Creators itself was instrumental in assisting 21 major department stores throughout the United States to hold whole-store California promotions of California merchandise that lasted all the way from three days to two weeks in the stores”. In each of the 21 selected cities the stores would carry on a wide-spread newspaper adver-

tising campaign “from two to four pages a day for the entire length of the promotion on California merchandise” [R. Tr. 352]. “Similar promotions” have taken place under the guidance of California Fashion Creators “for many years” [R. Tr. 353]. Mr. Woodard testified, in his expert opinion as a manufacturer familiar with the national market, that the use of the words “of California” constituted “*an added value*” utilized by virtually all members of his association [R. Tr. 366] and that “it is a *plus factor* in selling our merchandise” [R. Tr. 368].

Similarly, Mr. Weishar, the May Company buyer, answered the Court’s question as to whether there was general acceptance in the East of California-made dresses:

“Yes, I think this market is definitely growing and there is definite demand for this market back East.

The Court: The fact it is made in California is attractive?

The Witness: Yes.

The Court: And that is the distinguishing characteristic, you would say, from the standpoint of being able to make sales from dresses made in the West and those made in the East?

The Witness: I would say it has a definite appeal to a customer if it is made in California regardless of whose name is above it” [R. Tr. 476].

Mr. Herman Schechter, owner of California Buying Service, Incorporated, purchasing for more than 100 stores, testified to “a very large group of stores in the eastern states, particularly in New York” which drama-

tized their newspaper ads with California merchandise because:

“The California label alone seems to have the drawing appeal plus the colors and the specific type of garments that these people look for” [R. Tr. 495].

Even in California, Mr. Schechter testified, California merchandise is more easily salable:

“It is more acceptable in certain categories to people who live here because it is California merchandise” [R. Tr. 496].

In view of this *uncontradicted* evidence as to the value of the term and label “of California”, we submit the trial court was abundantly justified in making its findings that defendants adopted the term “of California” for a definitive purpose: to establish the origin and place of manufacture of their goods and to take full advantage of, and benefit from the widespread national advertising and promotion of California-manufactured goods by California Fashion Creators and department stores throughout the nation [R. 40-41].

At the trial [R. 32-33] plaintiff placed great stress upon the District Court decision in *California Apparel Creators v. Wieder of California*, 68 Fed. Supp. 499, *ignoring* the fact that this decision was appealed to the Circuit Court of Appeals, Second Circuit, which latter Court *contrary to plaintiff's assertion in the instant action*, expressly held that a geographical name *could* acquire secondary meaning and could be *protectible* under the law of unfair competition:

“But, as plaintiffs contend, a geographical name may acquire a secondary significance which will support an action for unfair competition.”



“In the development of this branch of the law the name or mark acquired its secondary or actionable significance as identification of the source of manufacture of the goods, and hence as showing the origin of the goods” (162 F. 2d 893, 897).

The *California Apparel* case, when properly analyzed [R. Tr. 359, 360] is *not* authority for the proposition that the term “‘of California’ has no secondary meaning”, as contended by plaintiff; but, on the contrary, it squarely holds that the combination of a man’s surname with his place of business may acquire secondary meaning and be protected by the courts:

“This seems particularly the case with reference to certain geographical names where through some combination of circumstances such a name may come to mean in the public mind not a single source, but a number, even though limited, of independent manufacturers or producers. Thus actions have been held maintainable for misrepresentation by appropriation of geographical names where products of the soil of certain localities were, because of climatic or other natural advantages, superior to similar products of other localities, *California Fruit Canners’ Ass’n v. Myer*, C.C.D. Md., 104 F. 82; *Harvey v. American Coal Co.*, 7 Cir., 50 F. 2d 832, certiorari denied 284 U.S. 669, 52 S. Ct. 43, 76 L.Ed. 566” (162 F. 2d 893, 898).

See also:

*Grand Rapids Furniture Co. v. Grand Rapids Furniture Co.*, 7 Cir., 127 F. 2d 245, 138 F. 2d 212, certiorari denied 321 U. S. 771, 64 S. Ct. 529, 88 L. Ed. 1066.

Plaintiff's counsel has completely misconceived the law of secondary meaning as applied to a trade-mark or firm-name which contains a geographical reference. Whether or not Eastern dress manufacturers copy or imitate California's vivid colors or color combinations is irrelevant. If, *in fact*, the words "of California" as contained in a dress label have acquired a secondary meaning in the mind of the public which identifies the product not only as having been manufactured in California but as having styling and color combinations which are characteristic of California merchandise and which are *particularly applicable to the manufacturer utilizing the term as part of his trade-mark, firm name or label*, then the term has intrinsic value and meaning both to the manufacturer and the public and is protectible by the courts. Plaintiff's assertion that the expression "of California" is "inherently incapable of distinguishing appellee's dresses" (App. Op. Br. p. 53) does violence to the entire concept of geographical terms acquiring secondary meaning and significance; the principle so well stated in *California Apparel Creators v. Wieder*, 162 F. 2d 893, 898; *California Fruit Cannery Association v. Myer*, 104 Fed. 82; *Grand Rapids Furniture Co. v. Grand Rapids Furniture Co.*, 7 Cir., 127 F. 2d 245, 138 F. 2d 212, certiorari denied 321 U. S. 771, 64 S. Ct. 529, 88 L. Ed. 1066.

*A fortiori*, in the case at bar the geographical reference is not combined with a bare description of the kind of business (*e.g.*, a fruit canner or a furniture manufacturer), but is combined with the surname of the general partner. The secondary meaning attached to "Sachs of California" thus identifies defendants' business, and only defendants' business, and is the kind

of designation current and customary in the dress manufacturing industry in this State [See Deft. Exs. P and Q, pp. 19-20, *supra*].

Appellant argues that the surname "Sachs" is the "dominant portion of appellees' trademark" (App. Op. Br. p. 52). As usual, appellant makes a series of assumptions which are not borne out by the evidence or by the trial court's decision in connection with this argument. The court did *not* decide that the words "of California" were "given an emphasis equal to that given the name 'Sachs'" (App. Op. Br. p. 52); nor was there any obligation upon the part of defendants to have "presented the phrase [of California] in a predominant manner" if they intended to rely upon it (App. Op. Br. p. 53). Appellant's argument that the words "of California" have *no significance whatever* and are "inherently incapable of distinguishing appellees' dresses" (App. Op. Br. p. 53) is a far different argument. As stated by appellant, the trial court found "both a primary and secondary meaning" attached to defendants' adoption and use of its trade-mark "Sachs of California". Appellant is in error in contending such meaning could not and did not attach to defendants adoption and use of the term. The evidence overwhelmingly supported the finding of the trial court that:

"Defendants adopted the term 'of California' to establish the origin and place of manufacture of their goods and to take full advantage of, and benefit from, the widespread national advertising and promotion of California-made goods" [R. 41].

The cases cited by appellant hold in substance that addition of a geographical word to an established trade-

mark will not justify its fraudulent misappropriation (e.g., “Riviera” by “Riviera of California”, *Ex parte Buddy Kit Co.*, 77 U. S. P. Q. 234; “Du Barry” by “Du Barry of Hollywood”, *Richard Hudnut v. Du Barry of Hollywood, Inc.*, 127 U. S. P. Q. 486; “Celeste” by “Celeste of Miami”, *Celeste Frocks, Inc. v. Celeste of Miami, Inc.*, 150 Fed. Supp. 604; *American Kennel Club v. American Kennel Club of La.*, 216 Fed. Supp. 267).

It should be noted that in each of the foregoing cases the registered trade-mark was misappropriated *in its entirety*, and the addition of the geographical word was held insufficient to avoid confusing similarity. In most of the cases fraudulent misappropriation was self-evident. In fact, in *Brooks Bros. v. Brooks Clothing of California, Ltd.*, 60 Fed. Supp. 442, the defendant omitted from all advertising and store signs the words “Clothing of California”, and “long ago abandoned all the words of its title except ‘Brooks’ in all its methods of seeking custom” (60 Fed. Supp. 442, 453).

Appellant fails to recognize the distinction between a manufacturer who truthfully represents his goods as manufactured in California and one who fraudulently does so, because, argues appellant, “the same type of dresses that are produced in California are produced in other areas in the United States” (App. Op. Br. p. 62). The argument begs the question. If a manufacturer *truthfully* represents he is a California manufacturer and *the trade, both wholesale and retail, identify such manufacturer with his product by use of his trade-mark or trade name, both primary and secondary significance attach.*

If the manufacturer's purpose in adopting the geographical term is to fraudulently misappropriate or colorably imitate another's well-established trade-mark or trade name, both the Patent Office and the courts have held such adoption and use to be unjustifiable. The trial court has found honesty and fair use by the defendants in the case at bar, and *in addition* has found no confusing similarity and no probability of confusion between plaintiff's and defendants' marks. Discussion of anything else is irrelevant.

### Conclusion.

It is only by isolated phrases taken out of context from the Memorandum of Decision, misinterpreting the phrases selected, and reading into them meanings and inferences never intended or applied by the District Court that the plaintiff can support its argument for reversal.

For each of the factual and legal reasons hereinbefore stated in this brief, we submit that the single surname, "Sachs", cannot be monopolized by plaintiff to the exclusion of all others, including the defendants. Such single surname was never given special emphasis or importance by plaintiff in any advertising or on labels or otherwise; it was always preceded and accompanied by the Christian names, "Paul Sachs" or "Don Sachs", in identical size, lettering, type and appearance. Furthermore, plaintiff used the word "*Original*" as a part of its trade-marks to identify its merchandise, to attract business, and to sustain its claim of "one store to a city".

Defendants never at any time traded upon plaintiff's advertising, or passed off its goods as plaintiff's. No reasonably sophisticated buyer would under any circumstances confuse either the trade-marks of the parties or their merchandise.

We submit the judgment of the trial court is abundantly sustained by the evidence and by the authorities hereinbefore cited, and such judgment should be affirmed.

Respectfully submitted,

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### Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

HAROLD A. FENDLER,

